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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,284	02/11/2004	Martin Zilliacus	NC27337Cont 9004.030	5467

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EXAMINER	
DOAN, DUYEN MY	

ART UNIT	PAPER NUMBER
2152	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/777,284	ZILLIACUS ET AL.	
	Examiner	Art Unit	
	DUYEN M. DOAN	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 June 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23-103* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *23-103* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7 IDSs*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The Preliminary Amendment filed on 9/30/2004. Claims 1-22 are cancelled. Claims 53-103 are newly added.

Information Disclosure Statement

The information disclosure statement filed 2/24/2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 50-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 50 recites a "server" that has "detector…determiner…interface…downloader". The use of the term "server" (i.e system/apparatus) does not inherently mean that the claim is directed towards a machine. Only if at least one the claimed elements of the

system is a physical part of a device can the system constitute a machine within the meaning of §101. There are no hardware or physical elements that would have led one of ordinary skill in the art to believe that the system is to be implemented as a machine. The claimed system is simply system software per se.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 23-103 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,832,230.

Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Application No. 10/777,284	Patent No. 6,832,230
A method for downloading applications stored in an application database that is coupled to a cellular communication network, said method comprising:	A method for downloading an application to a mobile terminal from an application database, the application database containing at least one application, said method comprising:
a) connecting a first mobile terminal with application database through cellular network, application database containing at least one application having a selectable lifetime;	a) choosing an application of the at least one application contained at the application database to download to the mobile terminal, wherein the at least one application has a selectable lifetime;
b) choosing an application…	b) selecting a lifetime…
c) providing the application…	c) downloading the chosen application...
d) selecting a lifetime…	d) storing indicia of the selected lifetime…
e) downloading the chosen application…	e) subsequently choosing
f) storing indicia of the selected lifetime…	f)determining…

g) again downloading…

h)incurring a fee

Although the conflicting claims are not identical, word by word, they are not patentably distinct form each other.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 23-41, 43-44, 50-58, 63-67, 69-70, 72-92, 96-97, 101-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al (us pat 6,366,791) (hereinafter Lin) in view of Griswold (us pat 5,940,504) (hereinafter Gris).

As regarding claim 23, Lin discloses a method for downloading applications stored in an application database that is coupled to a cellular communication network, said method comprising:

connecting a first mobile terminal (see col.3, lines 9-18, mobile terminal connect to the operator, the operator with the database in figure 3) with the application database through the cellular communication network, the application database containing at

least one application (see Lin col.4, col.4, lines 39-47, information such as ringing tone in the database);

choosing an application of the at least one application for downloading to the first mobile terminal (see Lin col.3, lines 9-20, mobile subscriber choosing the music ringing tone);

providing the application database with information identifying a user of the first mobile terminal (see Lin col.3, lines 21-34, operator provide music ring tone to user);

downloading the chosen application from said application database to the first mobile terminal (see Lin col.3, lines 21-34, see col.3, lines 60-65, download the music score); and

storing indicia of the chosen application and of the information identifying the user (see Lin col.4, lines 56-67, store the mobile subscriber and the selected musical score cited with that mobile number to receive the ringing tone).

Lin does not disclose selecting a lifetime for the chosen application, during which lifetime the chosen application is executable, the selected lifetime during which the chosen application is further executable at mobile terminals accessible by the user.

Gris discloses selecting a lifetime for the chosen application, during which lifetime the chosen application is executable (see Gris col.7, lines 3-27, the license product issued with a duration, the user is inherently chosen the lifetime for the selected product when the user pay for the license product), the selected lifetime during which the chosen application is further executable at mobile terminals accessible by the user (see Gris col.7, lines 35-46, the time the license executed at the client).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of Gris to the invention of Lin to include a life time for an application for the purpose of managing the licensed product (see Gris col.3, lines 31-48).

As regarding claim 24, Lin-Gris discloses downloading the chosen application is performed over a wireless connection (see Lin col.1, lines 39-40 wireless).

As regarding claim 25, Lin-Gris discloses downloading over a wireless connection is performed through the cellular communication network (see Lin col.1, lines 15-16).

As regarding claim 26, Lin-Gris discloses downloading over a wireless connection is achieved by way of a short-range connection (see Lin col.1, lines 15-24).

As regarding claim 27, Lin-Gris discloses wherein the short-range connection is an infrared connection (see Lin col.1, lines 15-24).

As regarding claim 28, Lin-Gris discloses the indicia is stored in an application-license database in connection with the application database (see Lin col.4, lines 56-67).

As regarding claim 29, Lin-Gris discloses wherein the information identifying the user is based on SIM information (see Lin col.4, lines 14, SIM).

As regarding claim 30, Lin-Gris discloses receiving in the application database a request from the user for a subsequent downloading of a previously-downloaded application (see Gris col.9, lines 1-14); determining whether lifetime remains by reference to the stored indicia of the selected lifetime for previously-downloaded application for the user (see Gris col.9, lines 1-14); and downloading the application a subsequent time, if it is determined that at least a portion of the selected lifetime remains for the requested application (see Gris col.9, lines 1-14). The same motivation was utilized in claim 23 applied equally well to claim 30.

As regarding claim 31, Lin-Gris discloses wherein the request is received from a second mobile terminal (see Lin col.2, lines 32-41).

As regarding claim 32, Lin-Gris discloses wherein the subsequent downloading comprises downloading the application to a second mobile terminal (see Gris col.11, lines 29-43). The same motivation was utilized in claim 23 applied equally well to claim 32.

As regarding claim 33, Lin-Gris discloses refusing the request for subsequent downloading if the determination indicates that lifetime has expired in the stored indicia

for said user (see Gris col.9, lines 1-14). The same motivation was utilized in claim 23 applied equally well to claim 33.

As regarding claim 34, Lin-Gris discloses downloading is performed over a wireless connection (see Lin col.1, lines 39-40).

As regarding claim 35, Lin-Gris discloses downloading over a wireless connection is performed through the cellular communication network (see Lin col.4, line 33).

As regarding claim 36, Lin-Gris discloses downloading over a wireless connection is achieved by way of a short-range connection (see Lin col.1, lines 15-24).

As regarding claim 37, Lin-Gris discloses wherein the short-range connection is an infrared connection (see Lin col.1, lines 15-24).

As regarding claim 38, Lin-Gris discloses wherein the lifetime is a period of time measured from a predetermined starting time (see Gris col.7, lines 30-57). The same motivation was utilized in claim 23 applied equally well to claim 38.

As regarding claim 39, Lin-Gris discloses the predetermined starting time is the time of downloading the chosen application (see Gris col.7, lines 30-57). The same motivation was utilized in claim 23 applied equally well to claim 39.

As regarding claim 40, Lin-Gris discloses the lifetime is a predetermined number of downloads (see Gris col.7, lines 22-26). The same motivation was utilized in claim 23 applied equally well to claim 40.

As regarding claim 41, Lin discloses in a communication system having at least one mobile terminal capable of communicating by way of a radio link with network infrastructure, the at least one mobile terminal having memory for at least one application, an improvement of apparatus for downloading an application to the at least one mobile terminal, said apparatus comprising:

an application database coupled to the network infrastructure, the application database containing at least one downloadable application (see Lin col.4, lines 56-67);

a detector coupled to the network infrastructure, the detector for detecting a request containing information identifying a user to download a chosen application of the at least one application contained at the application database, the detector for obtaining the application from the application database, and for downloading the application to the at least one mobile terminal to be installed thereat (see Lin col.3, lines 31-65);

Lin does not specifically discloses the application having a selectable lifetime during which the application is permitted to remain executable by an identified user; an application-license database coupled to the network infrastructure, the application-license database for storing the selected lifetime and the user-identifying information; and a downloading server, the downloading server coupled to the detector, the downloading server coupled to the application database, and the downloading server coupled to the application-license database; wherein the downloading server is configured to compare the download request to the selected lifetime and the user-identifying information stored in the application-license database for the chosen application, wherein the downloading server downloads said application if the user has application lifetime remaining for the requested application.

Gris discloses the application having a selectable lifetime during which the application is permitted to remain executable by an identified user (see Gris col.7, lines 1-14); an application-license database coupled to the network infrastructure, the application-license database for storing the selected lifetime and the user-identifying information (see Gris col.6, lines 62-67); and a downloading server, the downloading server coupled to the detector, the downloading server coupled to the application database, and the downloading server coupled to the application-license database (see Gris col.7, lines 30-57); wherein the downloading server is configured to compare the download request to the selected lifetime and the user-identifying information stored in the application-license database for the chosen application, wherein the downloading server downloads said application if the user has application lifetime remaining for the

requested application (see Gris col.7, lines 30-57; col.9, lines 14). The same motivation was utilized in claim 23 applied equally well to claim 41.

As regarding claim 43, Lin-Gris discloses wherein the selected lifetime expires as a function of a selected number of transactions (see Gris col.7, lines 1-27). The same motivation was utilized in claim 23 applied equally well to claim 43.

As regarding claim 44, Lin-Gris discloses wherein the lifetime expires as a function of a selected time (see Gris col.7, lines 1-27). The same motivation was utilized in claim 23 applied equally well to claim 44.

As regarding claims 50-52, the limitations of claims 50-52 are similar to limitations of rejected claims 23-40.

As regarding claims 53-58, 63-67, 69-70, 72-73, the limitations of claims 53-58, 63-67, 69-70, 72-73, are similar to limitations of rejected claims 23-40.

As regarding claims 74-85, the limitations of claims 74-85, are similar to limitations of rejected claims 23-40.

As regarding claims 86-92, 96-97,101-103, the limitations of claims 86-92, 96-97,101-103, are similar to limitations of rejected claims 23-40.

Claims 42, 45-49, 59-62, 68, 71, 93-95, 98-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin and Gris as applied to claim 41 above, and further in view of Mankoff (us pat 6,385,591).

As regarding claim 42, Lin-Gris discloses the invention as was disclosed in claim 41, Lin-Gris further discloses downloadable application is preprogrammed with the selected lifetime (see Gris col.7, lines 1-27), however Lin-Gris does not discloses wherein the downloadable application deletes itself from the at least one mobile terminal when the selected lifetime expires.

Mankoff discloses the concept of the expire content is automatically deleted (see Mankoff col.4, lines 35-37).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of Mankoff to the invention of Lin-Gris to delete the expired content for the purpose of preventing the unauthorized used of the content.

As regarding claim 45, Lin discloses a central processing unit (CPU) (see Lin col.4, lines 2-11, the CPU is inherently feature of the mobile terminal);
a memory unit coupled with the CPU for storing at least one application (see Lin col.4, lines 2-11, the memory is inherently feature of the mobile terminal); an application requestor coupled with the CPU for generating requests to
download a variable application from an application database (see Lin col.4, lines 2-11).

Lin does not specifically disclose a lifetime selector coupled with the CPU for selecting a lifetime applicable to a downloaded application; a lifetime determiner coupled with the CPU for determining the remaining portion of the lifetime associated with a downloaded application; and an application disabler coupled with the CPU for disabling an application; wherein the mobile terminal is operable to receive and store downloaded applications and to permit the downloaded application to be executed at the mobile terminal as long as a portion of the associated lifetime remains.

Gris teaches disclose a lifetime selector coupled with the CPU for selecting a lifetime applicable to a downloaded application (see Gris col.7, lines 1-26); a lifetime determiner coupled with the CPU for determining the remaining portion of the lifetime associated with a downloaded application (see Gris col.11, lines 44-67); wherein the mobile terminal is operable to receive and store downloaded applications and to permit the downloaded application to be executed at the mobile terminal as long as a portion of the associated lifetime remains (see Gris col.9, lines 1-14). The same motivation was utilized in claim 23 applied equally well.

The combination of Lin-Gris does not disclose an application disabler coupled with the CPU for disabling an application;

Mankoff discloses the concept of disabling an application (see Mankoff col.4, lines 34-36). The same motivation was utilized in claim 42 applied equally well to claim 45.

As regarding claim 46, Lin-Gris-Mankoff discloses wherein the application disabler disables an application when the associated lifetime has expired (see Mankoff col.4, lines 34-36). The same motivation was utilized in claim 42 applied equally well to claim 46.

As regarding claim 47, Lin-Gris-Mankoff discloses wherein the application disabler deletes an application with lifetime remaining in order to free storage space in the memory unit (see Mankoff col.4, lines 34-36). The same motivation was utilized in claim 42 applied equally well to claim 47.

As regarding claim 48, Lin-Gris-Mankoff discloses wherein the application requester is operable to request a previously-downloaded application for which at least a portion of the associated lifetime remains (see Gris col.9, lines 1-20). The same motivation was utilized in claim 23 applied equally well to claim 48.

As regarding claim 49, Lin-Gris-Mankoff discloses wherein the memory unit also stores lifetime indicia associated with downloaded applications (see Lin col.4, lines 12-29).

As regarding claims 59-62, 68, 71, the limitations of claims 59-62, 68, and 71 are similar to limitations of the rejected claims 45-49, therefore rejected for the same rationale.

As regarding claims 93-95, 98-99, the limitations of claims 93-95, 98-99 are similar to limitations of the rejected claims 45-49, therefore rejected for the same rationale.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DUYEN M. DOAN whose telephone number is (571)272-4226. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. M. D./
Examiner, Art Unit 2152

/Bunjob Jaroenchonwanit/
Supervisory Patent Examiner, Art Unit 2152